

(f) *Argument.* A request for rehearing shall state with particularity the points believed to have been misapprehended or overlooked by the Board. In filing a request for rehearing, the argument shall adhere to the following format: “On page x, lines y-z of the Board’s opinion, the Board states that (set out what was stated). The point misapprehended or overlooked was made to the Board in (identify paper, page and line where argument was made to the Board) or the point was first made in the opinion of the Board. The response is (state response).” As part of each response, appellant shall refer to the page number and line or drawing number of a document in the Record. A general restatement of the case will not be considered an argument that the Board has misapprehended or overlooked a point. A new argument cannot be made in a request for rehearing, except:

(1) *New ground of rejection.* Appellant may respond to a new ground of rejection entered pursuant to § 41.50(d)(2) of this subpart.

(2) *Recent legal development.* Appellant may rely on and call the Board’s attention to a recent court or Board opinion which is relevant to an issue decided in the appeal.

(g) *No amendment or new evidence.* No amendment or new evidence may accompany a request for rehearing.

(h) *Decision on rehearing.* A decision will be rendered on a request for rehearing. The decision on rehearing is deemed to incorporate the underlying decision sought to be reheard except for those portions of the underlying decision specifically modified on rehearing. A decision on rehearing is final for purposes of judicial review, except when otherwise noted in the decision on rehearing.

§ 41.54 Action following decision.

After decision by the Board, the proceeding will be returned to the examiner, subject to appellant’s right of appeal or other review, for such further action by appellant or by the examiner, as the condition of the proceeding may require, to carry into effect the decision.

EFFECTIVE DATE NOTE: At 73 FR 32977, June 10, 2008, § 41.54 was revised, effective December 10, 2008. For the convenience of the user, the revised text is set forth as follows:

§ 41.54 Action following decision.

After a decision by the Board and subject to appellant’s right to seek judicial review, the application or reexamination proceeding will be returned to the jurisdiction of the examiner for such further action as may be appropriate consistent with the decision by the Board.

§ 41.56 Sanctions.

(a) *Imposition of sanctions.* The Chief Administrative Patent Judge or an expanded panel of the Board may impose a sanction against an appellant for misconduct, including:

(1) Failure to comply with an order entered in the appeal or an applicable rule.

(2) Advancing or maintaining a misleading or frivolous request for relief or argument.

(3) Engaging in dilatory tactics.

(b) *Nature of sanction.* Sanctions may include entry of:

(1) An order declining to enter a docket notice.

(2) An order holding certain facts to have been established in the appeal.

(3) An order expunging a paper or precluding an appellant from filing a paper.

(4) An order precluding an appellant from presenting or contesting a particular issue.

(5) An order excluding evidence.

(6) [Reserved]

(7) An order holding an application on appeal to be abandoned or a reexamination proceeding terminated.

(8) An order dismissing an appeal.

(9) An order denying an oral hearing.

(10) An order terminating an oral hearing.

[73 FR 32977, June 10, 2008]

EFFECTIVE DATE NOTE: At 73 FR 32977, June 10, 2008, § 41.56 was added, effective December 10, 2008.

Subpart C—*Inter Partes* Appeals

§ 41.60 Definitions.

In addition to the definitions in § 41.2, the following definitions apply to proceedings under this subpart unless otherwise clear from the context:

Appellant means any party, whether the owner or a requester, filing a notice of appeal or cross appeal under § 41.61. If more than one party appeals or cross appeals, each appealing or cross appealing party is an appellant with respect to the claims to which his or her appeal or cross appeal is directed.

Filing means filing with a certificate indicating service of the document under § 1.903 of this title.

Owner means the owner of the patent undergoing *inter partes* reexamination under §1.915 of this title.

Proceeding means an *inter partes* reexamination proceeding. Appeal to the Board in an *ex parte* reexamination proceeding is controlled by subpart B of this part. An *inter partes* reexamination proceeding is not a contested case subject to subpart D.

Requester means each party, other than the owner, who requested that the patent undergo *inter partes* reexamination under §1.915 of this title.

Respondent means any requester responding under §41.68 to the appellant's brief of the owner, or the owner responding under §41.68 to the appellant's brief of any requester. No requester may be a respondent to the appellant brief of any other requester.

§41.61 Notice of appeal and cross appeal to Board.

(a)(1) Upon the issuance of a Right of Appeal Notice under §1.953 of this title, the owner may appeal to the Board with respect to the final rejection of any claim of the patent by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in §41.20(b)(1).

(2) Upon the issuance of a Right of Appeal Notice under §1.953 of this title, the requester may appeal to the Board with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in §41.20(b)(1).

(b)(1) Within fourteen days of service of a requester's notice of appeal under paragraph (a)(2) of this section and upon payment of the fee set forth in §41.20(b)(1), an owner who has not filed a notice of appeal may file a notice of cross appeal with respect to the final rejection of any claim of the patent.

(2) Within fourteen days of service of an owner's notice of appeal under paragraph (a)(1) of this section and upon payment of the fee set forth in §41.20(b)(1), a requester who has not filed a notice of appeal may file a notice of cross appeal with respect to any

final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent.

(c) The notice of appeal or cross appeal in the proceeding must identify the appealed claim(s) and must be signed by the owner, the requester, or a duly authorized attorney or agent.

(d) An appeal or cross appeal, when taken, must be taken from all the rejections of the claims in a Right of Appeal Notice which the patent owner proposes to contest or from all the determinations favorable to patentability, including any final determination not to make a proposed rejection, in a Right of Appeal Notice which a requester proposes to contest. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal is decided.

(e) The time periods for filing a notice of appeal or cross appeal may not be extended.

(f) If a notice of appeal or cross appeal is timely filed but does not comply with any requirement of this section, appellant will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended notice of appeal or cross appeal. If the appellant does not then file an amended notice of appeal or cross appeal within the set time period, or files a notice which does not overcome all the reasons for non-compliance stated in the notification of the reasons for non-compliance, that appellant's appeal or cross appeal will stand dismissed.

§41.63 Amendments and affidavits or other evidence after appeal.

(a) Amendments filed after the date of filing an appeal pursuant to §41.61 canceling claims may be admitted where such cancellation does not affect the scope of any other pending claim in the proceeding.

(b) All other amendments filed after the date of filing an appeal pursuant to §41.61 will not be admitted except as permitted by §41.77(b)(1).